

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-12 and 19-21 are presently active in this case. Claims 13-18 were cancelled by previous amendment. The present amendment adds new Claims 20-21 without introducing any new matter.

In the outstanding Office Action, Claims 1-12 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ito et al. (U.S. Patent No. 5,671,354, herein "Ito") in further view of Shiotsu et al. (U.S. Patent No. 6,993,358, herein "Shiotsu").

In response to the rejection of Claims 1-12 and 19 under 35 U.S.C. § 103(a), applicants respectfully request reconsideration of this rejection, and traverse the rejection, as discussed next.

Briefly recapitulating, Claim 1 relates to a communication system. The communication system includes, *inter alia*, a plurality of client terminal devices connected to a predetermined network, each client terminal device being assigned a unique identification number, and a communication server machine connected to the network and operable to manage, based on the identification numbers, user information related to each client terminal device. The user information indicates conditions under which each client terminal device is connected to the network. ***The conditions include a transmission band associated with each client terminal device,*** and further include ***a type of peripheral device associated with each client terminal device.***

Turning now to the applied references, Ito describes a method for assisting server access. In Ito, user authentication information for network access and a name of a server to be accessed are sent from a client terminal to a user management system operating on one of servers which constitute a network

system.<sup>1</sup> Thereby Ito's management system allows the user to know the actual accounts for the servers connected to the network by logging in on only one server.<sup>2</sup> Ito, however, fails to teach or suggest the claimed communication system. In particular, and as acknowledged by the outstanding Office Action at page 3, lines 1-3, Ito fails to teach or suggest the features regarding "conditions including at least a transmission band associated with each client terminal," and "wherein the conditions further include a type of peripheral device associated with each client terminal device" as required by Claim 1.

The outstanding Office Action rejects the above features based on the proposition that Shiotsu describes the above features,<sup>3</sup> and that it would have been obvious to modify Ito by importing these features from Shiotsu to arrive at applicants' claimed invention. Applicants respectfully submit, however, that Shiotsu fails to teach the above feature related to the conditions including a transmission band and a type of peripheral device associated with each client, as next discussed.

The outstanding Office Action relies on Shiotsu's disclosure at column 7, lines 20-30. This passage of Shiotsu recites that the user "modifies ... the transmission power default values . . . by entering the higher transmission power level  $H_i$  or  $H_{i,j}$  and the lower transmission power level  $L_{i,j}$  for each of the entered application programs." Reading Shiotsu, a person of ordinary skill in the art would understand that a user determining transmission power levels for different programs *is not* user information including conditions for network connection, wherein the conditions include a **transmission band** associated with each client terminal as required by Claim 1.

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<sup>1</sup> See Ito in the Abstract.

<sup>2</sup> See Ito at column 3, lines 5-8.

<sup>3</sup> See the outstanding Office Action at page 3, second paragraph.

In addition, Shiotsu fails to teach or suggest that the conditions further include a type of peripheral device associated with each client device. In Shiotsu, information processing devices 1-7 are engaged by their communication units in mutual communications,<sup>4</sup> and Shiotsu's information processing devices do not have any "peripheral devices associated with each client device," that are further required by applicants' Claim 1.

Therefore, even if the combination of Ito and Shiotsu is assumed to be proper, the combination fails to teach every element of independent Claim 1. Specifically, the combination fails to teach the "conditions including at least a transmission band associated with each client terminal," and "wherein the conditions further include a type of peripheral device associated with each client terminal device." Accordingly, applicants respectfully traverse, and request reconsideration of, this rejection based on these patents.

In addition, applicants respectfully traverse the obviousness-type rejection based on Ito and Shiotsu because there is insufficient evidence for a motivation to modify Ito's method for authenticating users accessing a network by incorporating Shiotsu's setting of transmission power level, for the following reasons.<sup>5</sup>

The outstanding Office Action states that the proposed modification would have been obvious "that The [sic] user may select a setting mode display on the personal computer 1 and

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<sup>4</sup> See Shiotsu at column 6, lines 45-53, and in Figure 1.

enter titles of available information processing devices data, such as types of the information processing devices with which the personal computer is to communicate or protocol by which communication is to be done. Then, he or she modifies, through a keyboard, the transmission power default values."<sup>6</sup> The record, however, fails to provide the **required evidence** for a motivation for a person of ordinary skill in the art to perform such modification of Ito. Assuming that Shiotsu provides a reason for using "titles of available information processing device data" in a system for adjusting transmission power to avoid inter-channel and co-channel interference,<sup>7</sup> Shiotsu fails to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in an authentication method for client terminals accessing a server, such as the one disclosed in Ito. In particular, Shiotsu uses the transmission power levels and available information processing devices in order to increase reliability of communications and to reduce interference between devices.<sup>8</sup> Shiotsu, however, does not suggest that the transmission power levels would work in an authentication method for managing user terminals and their accounts, much less "to increase efficiency of managing the network bandwidth and selecting a more efficient transmission rate," as stated in the outstanding Office Action at page 4, lines 1-2. Shiotsu clearly does not state that the setting of transmission power level to avoid interference needs

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<sup>5</sup> See M.P.E.P. § 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

<sup>6</sup> See outstanding Office Action at page 3, paragraph 2.

<sup>7</sup> See Shiotsu in the Abstract and at column 3, lines 36-42.

"increase[d] efficiency of managing the network bandwidth and selecting a more efficient transmission rate."

In addition, Ito is not concerned with titles of available application programs and transmission power levels. Instead, Ito is concerned with user authentication and access account management. The titles of available application programs, types of information processing devices, and transmission power,<sup>9</sup> are irrelevant for Ito's authentication. Ito states that its structure already achieves the goal of allowing the user to collectively know the actual accounts for the servers connected to the network.<sup>10</sup> Ito does not suggest that further improvement is desired, nor that another feature should be added to further improve the efficiency of managing the network bandwidth and selecting a more efficient transmission rate.

Ito and Shiotsu, therefore, do not provide the motivation to perform the proposed modification of Ito. In other words, an attempt to bring in the isolated teaching of Shiotsu's setting of a transmission power level into Ito would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.<sup>11</sup> While the required evidence of motivation to combine need not come from the applied references themselves, the

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<sup>8</sup> See Shiotsu at column 3, lines 31-42.

<sup>9</sup> See Shiotsu at column 3, lines 20-25.

<sup>10</sup> See Ito, for example, at column 6, lines 54-59.

<sup>11</sup> See *In re Ehrreich*, 590 F.2d 902, 200 U.S.P.Q. § 504 (CCPA 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

evidence must come from *somewhere within the record*.<sup>12</sup> In this case, the record fails to support the proposed modification of Ito. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.<sup>13</sup> Without such motivation and absent improper hindsight reconstruction,<sup>14</sup> a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-12 and 19 are believed to be non-obvious and patentable over the applied references.

Independent Claims 2-3, 6 and 9-10, recite features analogous to the features recited in independent Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, applicants respectfully submit that the rejections of Claims 2-3, 6 and 9-10, and the rejection of all associated dependent claims, are also believed to be overcome.

To vary the scope of protection recited in the claims, new Claims 20-21 are added. New Claim 20 depends upon Claim 1 and recites "the type of peripheral device includes at least one of a microphone or a camera."<sup>15</sup> New Claim 21 depends upon Claim 1 and recites features regarding a transmission bit rate.<sup>16</sup> Since the new claims find non-limiting support in the disclosure as

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<sup>12</sup> *In re Lee*, 277 F.3d 1338, 1343-44, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record . . . [The] factual question of motivation . . . cannot be resolved on subjective belief and unknown authority . . . Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

<sup>13</sup> See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

<sup>14</sup> See MPEP 2141, stating, as one of the tenets of patent law applying to 35 U.S.C. § 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

<sup>15</sup> Finds non-limiting support in applicants' disclosure as originally filed, for example at page 7, lines 12-14.

originally filed, they are not believed to raise a question of new matter.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicants' representative at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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<sup>16</sup> Idem at page 9, lines 10-15, and page 11, lines 4-15, and in corresponding Figure 3.